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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 744,497	01 24 2001	Jean-Marie Bernard	RN98105	8745

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EXAMINER

TOOMER, CEPHA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 18-39 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 18-39 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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### DETAILED ACTION

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The disclosure is objected to because of the following informalities: the term "[lacuna]" appears several times in the specification (pages 9, 11, 14 and 15). Is this a typographical error or should the term be deleted?. If this is not a typographical error, what does the term mean?

Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: there is no support in the specification for "at least one di-or polymethylene linkage" (claim 21); "substituted at most once" (claim 23); "imidazolidione, isocyanuric, allophanate, or polyol carbamate functional group" (claim 24); "A coating composition" (claims 37 and 39).

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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2. Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the original filed specification for "at least equal to 0.7."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22, 24, 32 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 is rejected because there is no antecedent support in claim 18 for the (co)oligomers".

Claim 24 is rejected because there is no antecedent support in claim 18 for said "(co)oligomer".

Claim 32 is rejected because there is no antecedent support in claim 18 for the isocyanate functional groups.

Claim 34 is rejected because there is no antecedent support for "the molten masked isocyanate".

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*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18, 19, 21, 28, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Gras (U.S. 5,149,805).

Gras teaches that the process of blocking IPDI (3-isocyanatomethyl-3, 5, 5-trimethylcyclohexylisocyanate) with epsilon caprolactam. The resulting product contains blocked IPDI AND 16% non-converted IPDI (see col. 1, lines 29-55).

Accordingly, Gras teaching all the material limitations of the claims, anticipated the claims.

Claims 18-32, and 34-39 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 822210.

EP 822210 and U.S. 6,291,624 are of the same patent family. Therefore, U.S. 6,291,624 will be used as a translation for the EP reference.

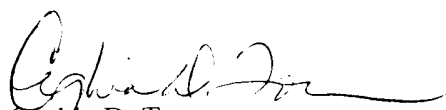
EP teaches coating (powder) compositions containing masked and unmasked isocyanate compounds. The isocyanate skeleton contains at least one polymethylene chain and at least two isocyanate functions. The isocyanates are derived from polyisocyanates made of the biuret type or those whose di-or trimerization reaction has produced 4-, 5- or 6-membered rings, such as

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isocyanuric rings (see abstract; col. 3, lines 36-65; col. 4, lines 3-12). EP uses a mixture of hexamethylene diisocyanate trimer with IPDI trimer (see col. 4, lines 13-37). EP teaches that the isocyanate composition contain at most 5% of unmasked isocyanate compound and also that up to 1/3 mass of unmasked isocyanate trimers of cycloaliphatic monomers, such as IPDT may be added to the molten masked isocyanate compound in order to favorable effect the glass transition temperature (see col. 8, lines 8-44).

Accordingly, EP teaching all the material limitations of the claims anticipates the claims.

Any inquiry concerning this communication should be directed to Cephia D. Toomer at telephone number (703) 308-2509.



Cephia D. Toomer

Patent Examiner-1714

Toomer:mv

April 1, 2002